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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/433,202 11/04/99 REITZ H N19.12-0026

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EXAMINER

MARCHESCHI, M

ART UNIT

PAPER NUMBER

1755

DATE MAILED:

02/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/433,202

Applicant(s)

Reitz et al.

Examiner

Michael Marcheschi

Group Art Unit

1755

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) 33-38 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-32 is/are rejected.

☒ Claim(s) 16 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☒ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-32, drawn to polishing dispersion and method of polishing, classified in class 51, subclass 309.
- II. Claims 33-38, drawn to coated device, classified in class 428, subclass 195

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a dispersion for forming a ceramic article (i.e. a flower pot) and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. In addition the groups are independent and distinct inventions.

Because these inventions are distinct for the reasons given above and (1) have acquired a separate status in the art as shown by their different classification, (2) the search required for Group I is not required for Group II, and (3) have acquired a separate status in the art because of

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their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Peter S. Dardi on February 23, 2000 a provisional election was made with traverse to prosecute the invention of group I, claims 1-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 33-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

The use of the trademarks 'PYREX' (page 17), 'SWAGELOK' (page 17), 'TEFLON' (page 25, page 33), 'NOMEX' (page 25), 'PLASTICOL' (page 31), 'DOXFAX' (page 43) TRITON (page 43) and any other trademarks have been noted in this application. They should be **CAPITALIZED** wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

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Claim 1-28 and 31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 28 are indefinite as to the phrase 'effectively no' since the examiner is unclear as to what this encompasses. This phrase does not define a clear limitation, thus rendering the scope of the claims unclear. This phrase should be canceled.

Claims 5-9 are indefinite because the phrase 'the solvent' lacks antecedent basis since a 'solvent' has not been **literally** defined before.

Claim 23 is indefinite as to the phrase 'effectively having no' since the examiner is unclear as to what this encompasses. This phrase does not define a clear limitation, thus rendering the scope of the claim unclear. This phrase should be canceled.

Claim 27 is indefinite because it is not drafted in a clear and concise manner, thus rendering the scope of the claim unclear. In lines 2, 4 and 6, what is the "composition"?

Claim 31 is indefinite because it is not drafted in a clear and concise manner, thus rendering the scope of the claim unclear. What is this claim defining?

The other claims are indefinite because they depend on indefinite claims.

Claim 16 is objected to because of the following informalities:

In claim 16 line 3, before 'carboxylic', the term "**and**" should be inserted. Appropriate correction is required.

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The application papers are objected to (~~claims objected to~~) because they are not a permanent copy as required by 37 CFR 1.52(a). Reference is made to the claims which are easily erasable.

Applicant is required either (1) to submit permanent copies of the identified parts or (2) to order a photocopy of the above identified parts to be made by the Patent and Trademark Office at applicant's expense for incorporation in the file. See MPEP § 608.01.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) ~~Ishitobi et al.~~ alone or in view of Farkas et al., (2) Grover et al. alone or in view of Farkas et al. or (3) Kaufman et al. alone or in view of Farkas et al.

Ishitobi et al. teach in the abstract, column 3, lines 40-45, column 5, lines 49-50 and the claims, a polish comprising a dispersion (in water) of 2-20% zirconia having a size of 0.001-0.3 microns. The polish can have any pH value (i.e. no limitation is placed on the pH

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because it is stated that an acid or base can be added, thus defining all the possible pH values) and can contain an oxidizing agent and a surface active agent.

Grover et al. teach in column 2, lines 43-50, column 4, line 18-column 5, line 63, and column 6, lines 37-45, a polish comprising a dispersion (in water) of 2-25% of polishing particles having a nanometer particle size. The polish can have a pH value of 3-11 and contain carboxylic acid, a surfactant and an oxidizer.

Kaufman et al. teach in column 3, lines 8-15, column 4, lines 47-55, column 5, lines 50-54 and column 6, lines 39-45, a polish comprising a dispersion (in water) of 1-9% of polishing particles having a size less than 400 nm. The polish can have a pH value of about 2-about 8 and contain a surfactant and an oxidizer.

Farkas et al. teach in the abstract and column 6, lines 14-24 that in polishing composition, the solvent can either be water, alcohol or a mixture thereof. In addition, it is shown that oxidizing agents are conventionally added to polishing compositions.

All the primary references teach polishes comprising polishing particles having a size within the claimed range and therefore no distinction is seen to exist because the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)". With respect to the use of a nonaqueous solvent as the dispersing medium, it is the examiners position that this

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feature is an obvious modification thereof and one skilled in the art would have routinely known that either water or another solvent (nonaqueous) can be used as the dispersing medium. In the alternative, Farkas et al. teach that this concept is well known (either medium can be used). With respect to the polishing process, all the references teach limitations which encompass the instant polishing process, thus making the claimed process obvious. In addition, it is the examiners position that the polishes according to all the references will abrade the surface of a substrate to produce the claimed roughness in the absence of any evidence showing the contrary. The size of the particles determines the roughness and since the size is the same, it is expected that the surface roughness produced will be the same.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over either **(1)** Miyashita et al. in view of Farkas et al. or **(2)** Brancaleoni et al. in view of Farkas et al.

Miyashita et al. teach in the abstract, column 5, line 64-column 6, line 24, column 10, line 56-column 11, line 8 and column 13, line 58-column 14, line 23, a polish comprising a dispersion (in water) of an polishing particles (silicon nitride, silicon carbide or graphite) having a nanometer particle size. The polish can have any pH value (i.e. no limitation is placed on the pH because it is stated that an acid or base can be added, thus defining all the possible pH values) and can contain a surfactant. This reference fails to teach the amount of polishing particles and the use of an oxidizing agent.

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Brancaleoni et al. teach in column 4, line 67-column 5, line 68 and the claims, a polish comprising a dispersion (in water) of 5-25% polishing particles having a nanometer particle size. The polish can have a pH value of about 4-12 and contain a surfactant. This reference fails to teach the use of an oxidizer.

The primary references teach polishes comprising polishing particles having a size within the claimed range and therefore no distinction is seen to exist because the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)". It is also the examiners position that since the Miyashita et al. fails to define an amount for the polishing particles, this implies to one skilled in the art that the amount used is a conventional amount and since the claimed amount defines a conventional amount, it is obvious. In addition, it is the examiners position that since the reference fails to mention any specific amount (criticality), this (the absence of any such limitation) constitutes a broad teaching of amounts, as long as the final polish is obtained. In view of this, it can be reasonably interpreted that the claimed amount is encompassed by the broad teachings according to the reference in the absence of any evidence showing the contrary (criticality). It is also the examiners position that it would have been obvious to add an oxidizing agent in the polishes according to both references because Farkas et al. teach that this additive is conventionally added to polishes and the use of any known polishing

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additive would have been well within the level of ordinary skill in the art. With respect to the use of a nonaqueous solvent as the dispersing medium, it is the examiners position that this feature is an obvious modification thereof and one skilled in the art would have routinely known that either water or another solvent (nonaqueous) can be used as the dispersing medium. In the alternative, Farkas et al. teach that this concept is well known (either medium can be used). With respect to the polishing process, all the references teach limitations which encompass the instant polishing process, thus making the claimed process obvious. In addition, it is the examiners position that the polishes according to all the references will abrade the surface of a substrate to produce the claimed roughness in the absence of any evidence showing the contrary. The size of the particles determines the roughness and since the size is the same, it is expected that the surface roughness produced will be the same.

Claims 1-4 and 7-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Picardi et al. in view of Ishitobi et al. and Farkas et al., (2) Hirabayashi et al. in view of Ishitobi et al. and Farkas et al. or (3) Sasaki in view of Ishitobi et al. and Farkas et al.

Picardi et al. teach in the abstract, column 7, lines 50-54 and the claims, a polish comprising an alkaline dispersion (in water) of ceria and silica having a size less than 100 nm. The polish can also contain an oxidizing agent. This reference fails to teach the use of a surfactant.

Hirabayashi et al. teach in the abstract and column 4, line 20-column 5, line 7, a polish comprising a dispersion (in water) of 3-10% of polishing particles (silica, alumina, ceria, zirconia)

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having a size of 0.02-0.1 microns. The polish can have a pH of 9-14 and contain an oxidizing agent. This reference fails to teach the use of a surfactant.

Sasaki teaches in the abstract, column 2, lines 36-40 and the claims, a polish comprising a dispersion (in water) of at least 0.1% silica having a minimum size of 5 millimicrons. The polish can have a pH value of 8-12. This polish fails to contain a surfactant and an oxidizer.

The primary references teach polishes comprising polishing particles having a size within the claimed range and therefore no distinction is seen to exist because the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)". It is also the examiners position that since the Picardi et al. fails to define an amount for the polishing particles, this implies to one skilled in the art that the amount used is a conventional amount and since the claimed amount defines a conventional amount, it is obvious. In addition, it is the examiners position that since the reference fails to mention any specific amount (criticality), this (the absence of any such limitation) constitutes a broad teaching of amounts, as long as the final polish is obtained. In view of this, it can be reasonably interpreted that the claimed amount is encompassed by the broad teachings according to the reference in the absence of any evidence showing the contrary (criticality). It is also the examiners position that it would have been obvious to add a surfactant and an oxidizer (as in the case of Sasaki) in the polishes according to all the references

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because Ishitobi et al. teach that this (these) additive(s) is (are) conventionally added to polishes and the use of any known polishing additive would have been well within the level of ordinary skill in the art. With respect to the use of a nonaqueous solvent as the dispersing medium, it is the examiners position that this feature is an obvious modification thereof and one skilled in the art would have routinely known that either water or another solvent (nonaqueous) can be used as the dispersing medium. In the alternative, Farkas et al. teach that this concept is well known (either medium can be used). With respect to the polishing process, all the references teach limitations which encompass the instant polishing process, thus making the claimed process obvious. In addition, it is the examiners position that the polishes according to all the references will abrade the surface of a substrate to produce the claimed roughness in the absence of any evidence showing the contrary. The size of the particles determines the roughness and since the size is the same, it is expected that the surface roughness produced will be the same.

Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) Atsugi et al. in view of Ishitobi et al. and Farkas et al. or (2) Rostoker et al. (194) in view of Ishitobi et al. and Farkas et al.

Atsugi et al. teach in column 3, lines 9-20 and column 4, lines 8-50, a polish comprising a dispersion (in water) of 0.05-30% alumina having a size of 40 nm or less. The polish can have any pH value (i.e. no limitation is placed on the pH) and can contain an oxidizing agent. This polish fails to contain a surfactant.

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Rostoker et al. (194) teach in the abstract, column 4, lines 22-24, column 7, lines 36-44 and the claims, a polish comprising a slurry (encompasses water) of alumina having a size of 10-100 nm. The polish can have any pH value (i.e. no limitation is placed on the pH). This polish fails to contain a surfactant and an oxidizer.

The primary references teach polishes comprising polishing particles having a size within the claimed range and therefore no distinction is seen to exist because the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)". It is also the examiners position that since the Rostoker et al. fails to define an amount for the polishing particles, this implies to one skilled in the art that the amount used is a conventional amount and since the claimed amount defines a conventional amount, it is obvious. In addition, it is the examiners position that since the reference fails to mention any specific amount (criticality), this (the absence of any such limitation) constitutes a broad teaching of amounts, as long as the final polish is obtained. In view of this, it can be reasonably interpreted that the claimed amount is encompassed by the broad teachings according to the reference in the absence of any evidence showing the contrary (criticality). It is also the examiners position that it would have been obvious to add a surfactant and an oxidizer (as in the case of Rostoker et al.) in the polishes according to all the references because Ishitobi et al. teach that this (these) additive(s) is (are)

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conventionally added to polishes and the use of any known polishing additive would have been well within the level of ordinary skill in the art. With respect to the use of a nonaqueous solvent as the dispersing medium, it is the examiners position that this feature is an obvious modification thereof and one skilled in the art would have routinely known that either water or another solvent (nonaqueous) can be used as the dispersing medium. In the alternative, Farkas et al. teach that this concept is well known (either medium can be used). With respect to the polishing process, all the references teach limitations which encompass the instant polishing process, thus making the claimed process obvious. In addition, it is the examiners position that the polishes according to all the references will abrade the surface of a substrate to produce the claimed roughness in the absence of any evidence showing the contrary. The size of the particles determines the roughness and since the size is the same, it is expected that the surface roughness produced will be the same.

Claims 1-4, 7-18 and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haisma et al. in view of Ishitobi et al. and Farkas et al.

Haisma et al. teach in the abstract, column 3, lines 33-51 and the claims, a polish comprising a dispersion (in water) of approximately 50% silica having a size of 20-50 nm. The polish can have a pH value of 10 and can contain an oxidizing agent. This polish fails to contain a surfactant.

The primary reference teaches a polish comprising polishing particles having a size within the claimed range and therefore no distinction is seen to exist because the subject matter as a

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whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)". It is also the examiners position that it would have been obvious to add a surfactant in the polish according to the reference because Ishitobi et al. teach that this additive is conventionally added to polishes and the use of any known polishing additive would have been well within the level of ordinary skill in the art. With respect to the use of a nonaqueous solvent as the dispersing medium, it is the examiners position that this feature is an obvious modification thereof and one skilled in the art would have routinely known that either water or another solvent (nonaqueous) can be used as the dispersing medium. In the alternative, Farkas et al. teach that this concept is well known (either medium can be used). With respect to the polishing process, all the references teach limitations which encompass the instant polishing process, thus making the claimed process obvious. In addition, it is the examiners position that the polishes according to all the references will abrade the surface of a substrate to produce the claimed roughness in the absence of any evidence showing the contrary. The size of the particles determines the roughness and since the size is the same, it is expected that the surface roughness produced will be the same.

In all of the above rejections, the following apply:

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With respect to claim 25, applicants use process limitations to define the product and "product-by-process" claims do not patentably distinguish the product even though made by a different process. *In re Thorpe* 227 USPQ 964.

The examiner acknowledges that some of the ranges are slightly outside that claimed ranges but since the term "about" is used in both the references and claimed invention, no patentable distinction is seen to exist in the absence of any critical evidence showing the contrary because "about" permits some tolerance, *In re Ayers*, 154 F.2d 182, 69 USPQ 109.

The desired particle size is a function of the application and mere recitation of that size does not represent a patentable distinction over these references to one of ordinary skill in the art, lacking evidence to the contrary.

All the references teach polishes comprising polishing particles having a size within the claimed range and in the absence of a declaration showing that the claimed size provides unexpected results with respect to the dispersion, no distinction is seen to exist.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over either (1) all the pending claim of copending Application No. 08/961,735 in view of Ishitobi et al. and Farkas et al., (2) claims 9-15 of copending Application No. 09/085,514 in view of Ishitobi et al. and Farkas et al., (3) claims 9-15 of copending Application No. 09/136,483 in view of Ishitobi et al. and Farkas et al., or (4) all the pending claims of copending Application No. 09/266,202 in view of Ishitobi et al. and Farkas et al.

The copending applications all teach dispersions (polishes) comprising particles having sizes within the claimed range and therefore no distinction is seen to exist because the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 U.S.P.Q. 549; *In re Wertheim* 191 USPQ 90 (CCPA 1976)". It is also the examiners position that since the copending applications fail to define an amount for the polishing particles, this implies to one skilled in the art the amount used is a conventional amount and since the claimed amount defines a conventional amount, it is obvious. In addition, it is the examiners position that since the copending applications fail to mention any specific amount (criticality), this (the absence of any such limitation) constitutes a broad teaching of amounts, as long as the final

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polish is obtained. In view of this, it can be reasonably interpreted that the claimed amount is encompassed by the broad teachings according to the copending applications in the absence of any evidence showing the contrary (criticality). It is also the examiners position that it would have been obvious to add a surfactant and an oxidizer in the polishes according to the copending application because Ishitobi et al. teach that these additives are conventionally added to polishes and the use of any known polishing additive would have been well within the level of ordinary skill in the art. Although all of the copending applications fail to claim a polishing method, this method is an obvious variation of the copending claims. In addition, it is the examiners position that the polishes according to all the copending applications will abrade the surface of a substrate to produce the claimed roughness in the absence of any evidence showing the contrary. The size of the particles determines the roughness and since the size is the same, it is expected that the surface roughness produced will be the same.

In view of the teachings as set forth above, it is the examiners position that the references reasonably teach or suggest the limitations of the rejected claims.

“A reference is good not only for what it teaches but also for what one of ordinary skill might reasonably infer from the teachings. *In re Opprecht* 12 USPQ 2d 1235, 1236 (CAFC 1989); *In re Bode* USPQ 12; *In re Lamberti* 192 USPQ 278; *In re Bozek* 163 USPQ 545, 549 (CCPA 1969); *In re Van Mater* 144 USPQ 421; *In re Jacoby* 135 USPQ 317; *In re*

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LeGrice 133 USPQ 365; *In re Preda* 159 USPQ 342 (CCPA 1968)". In addition, "A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421. "A generic disclosure renders a claimed species *prima facie* obvious. *Ex parte George* 21 USPQ 2d 1057, 1060 (BPAI 1991); *In re Woodruff* 16 USPQ 2d 1934; *Merk & Co. v. Biocraft Lab. Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1983); *In re Susi* 169 USPQ 423 (CCPA 1971)".

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

The additional references cited on the 1449 have been reviewed by the examiner and are considered to be art of interest since they are cumulative to or less than the art relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Marcheschi whose telephone number is (703) 308-3815. The examiner can be normally be reached on Monday through Thursday between the hours of 8:30-6:00 and every other Friday between the hours of 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Mark L. Bell, can be reached at (703) 308-3823.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Michael Marcheschi
Art unit 1755
2/00


MICHAEL MARCHESCHI
PRIMARY EXAMINER